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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,549	09/07/2001	Roberto Messina	RC/MF-39639	9821

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EXAMINER

CIRIC, LJILJANA V

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,549

Applicant(s)

Messana

Examiner

Ljiljana V. Ciric *LVC*

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 7, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 12-15 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 23, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119 (a)-(d). The certified copy has been filed in parent Application No. PCT/IB99/01864, filed on November 22, 1999.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s): a middle axis of the panel (P) as recited in claim 4; lines (L) separating adjacent modules being highlighted on the external surface of the panel (P) as recited in claim 6; and, the pipe (3) comprising a continuous metal wire incorporated in the wall of the pipe as recited in claim 10. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because the second sentence thereof is a run-on sentence, and as such contains grammatical informalities and is not particularly clear as written. Correction is required. See MPEP § 608.01(b).

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4. The disclosure is objected to because of the following informalities: page 3 (amended sheet 3) contains at least one added line which is single spaced from adjoining lines.

Appropriate correction is required.

Claim Objections

5. Claims 1 through 12 and 16 through 20 as amended via the preliminary amendment are objected to because of the following informalities: “Prefabricated” [claim 1, line 1] should be replaced with “A prefabricated”; “Radiating panel” [line 1 of each of claims 2 through 12 and 16 through 20] should be replaced with “A radiating panel”; “as claimed in Claim ??” [claim 12, line 1, as appearing in the “clean” version of claim 12] should be replaced with “as claimed in Claim 1” as noted in the corresponding marked-up version of the claim in order to provide correct dependence for claim 12. Appropriate correction is required.

6. Claims 13 through 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Method claims 13 through 15 refer back to apparatus claim 1 and appear to depend from apparatus claim 1, but fail to further limit the apparatus recited in claim 1.

Claim Rejections - 35 U.S.C. § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1 through 11 and 16 through 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and contain grammatical and idiomatic errors.

For example, there is insufficient antecedent basis for the following limitations in the claims: “the end portions (4) of each of said independent hydraulic circuits” [claim 2, lines 1-2]--note that the circuits do not inherently have end portions; “the short side of the panel (P)” [claim 5, line 2]--note that the panel does not inherently have a short side; “the lines (L) separating adjacent modules” [claim 6, lines 1-2]; “the lines (11)” [claim 8, line 3]; “the thermal carrier fluid” [claim 8, line 3]; “the end portions (4) of the pipes” [claim 16, line 5]; “the said end portions” [claim 16, line 7]; “the strip joining together non-adjacent panels” [claim 17, lines 4-5]; “said metal sections” [claim 18, line 2]--note that there would be sufficient antecedent basis for “said metal support sections”; “the strips” [claim 19, line 3]; and, “said Ω -shaped metal sections” [claim 20, lines 1-2]--note that there would be sufficient antecedent basis for “said Ω -shaped metal support sections”.

Regarding base claim 1 as written, it is not clear to which element or elements the term “of which” in the limitation “the end portions *of which* emerge from a side of the panel” as recited in lines 3-4 of the claim, thereby rendering indefinite claim 1 and all claims depending therefrom.

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Recommend replacing the term “of which” with a direct recitation of the element or elements referred to thereby.

Also with regard to base claim 1 as written, it is not clear what is included and what is excluded by the limitation “in a modular manner” appearing in line 8 of the claim.

With regard to claim 2 as written, it is not clear to which element or elements the indeterminate term “thereof” appearing in line 3 of the claim refers. Recommend replacing the term “thereof” with a direct recitation of the element or elements referred to thereby.

With regard to claim 3 as written, the limitations “wherein said zones (6) have all the same area and house all the same length of said pipe (3)” are generally incomprehensible as written.

Regarding claim 6 as written, the phrase “and the like” renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by “or the like”), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 7 as written, the recitation of “an amount sufficient to allow said end portions (4) to emerge freely from the plasterboard layer (1) *and allow direct fixing of the plasterboard panel (P) to supporting sections (9, 10)*” is not clear as written and furthermore appears to refer to a variable amount which is not clearly defined by the claim or by the specification, thereby rendering the claim indefinite with regard to the scope of protection sought.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the

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explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 11 recites the broad recitation "made of metallic material", and the claim also recites "preferably stainless steel" which is the narrower statement of the range/limitation.

The limitations following "characterized in" in claim 16 as written are generally incomprehensible, rendering the claim indefinite with regard to the scope of protection sought.

The above is an indicative, but not necessarily an exhaustive, list of 35 U.S.C. 112, second paragraph, problems. Applicant is therefore advised to carefully review all of the claims for additional problems. Correction is required of all of the 35 U.S.C. 112, second paragraph problems, whether or not these were particularly pointed out above.

Claim Rejections - 35 U.S.C. § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. As best can be understood in view of the indefiniteness of the claims, claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by *Milborn*.

Milborn discloses a prefabricated radiating panel essentially as claimed, including: a "plasterboard" layer 10; a heat-insulating layer 6; and pipes or conduits 3 arranged in a coiled outline [see Figure 1] and forming a hydraulic circuit with an inlet and an outlet.

The reference thus reads on the claims.

11. The non-application of art against claims 2 through 11 and 16 through 20 should not be construed as an indication that the claims contain allowable subject matter but rather that the claims could not be examined on the merits due to indefiniteness.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Norell et al.* and *Kobayashi* are of particular interest since these disclose prefabricated multi-layer radiating panels with coiled conduits disposed therein as in the instant invention. *Shelley, Yoshio et al., Bourne et al., Umina, Andersson et al.,* and *Fiedrich* disclose various state-of-the-art radiating panels of interest.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925. While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric

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may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett, can be reached on (703) 308-0101. The fax phone number is (703) 305-3463.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

December 14, 2002



LJILJANA V. CIRIC
PRIMARY EXAMINER
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